

**REMARKS**

The Office Action mailed December 31, 2003 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1 and 3-11 were pending in the application. Claims 1, 3, 5, 7, and 10 have been amended, claims 4, 6, and 11 have been canceled and no claims have been newly added. Therefore, claims 1, 3, 5, and 7-10 are pending in the application and reconsideration is respectfully requested.

This amendment changes and cancels claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

In the Office Action, claims 1, 3-5, 9, and 10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,995,014 to DiMaria (hereafter "DiMaria '014"). Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over DiMaria '014 as applied to claim 1 above, and further in view of U.S. Patent No. 5,959,541 to DiMaria et al. (hereafter "DiMaria '541"). Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DiMaria '014 as applied to claim 1 above, and further in view of U.S. Patent No. 6,185,318 to Jain et al. (hereafter "Jain"). Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over DiMaria '014 as applied to claim 1 above, and further in view of U.S. Patent No. 5,465,303 to Levison et al. Applicants respectively traverse these rejections, insofar as they may be applied to the pending claims, for at least the following reasons.

Amended claim 1 recites a temporary recording unit that stores temporary fingerprint data of a fingerprint. Amended claim 3 recites that the temporary data is raw fingerprint data. Claim 5 recites that the temporary data is the corrected or compressed fingerprint data. Claim 7 recites that the temporary data are extracted image features. Claim 10 recites the step of recording temporary fingerprint data.

As stated in the specification, one of the objectives of the present invention is to provide a fingerprint identification device to identify fingerprints which, when malfunctioning, readily allows the location of the malfunction to be ascertained. In order to find out such location of a malfunction easily, the fingerprint identification device according

to the present invention is equipped with a temporary recording unit which stores either the raw fingerprint data, the corrected or compressed fingerprint data, or the extracted image features, all of which are stored only when said fingerprint comparing unit does not identify said input fingerprint. The temporary recording unit makes it possible for maintenance people to check these stored data to easily find out the location of the malfunction. Further, these data need only a compact memory size when they are stored in the user recording unit.

In contrast, none of the references which form the basis of the rejection discloses the temporary recording unit. The temporary recording unit in the present claims can store either the raw fingerprint data, the corrected or compressed fingerprint data, or the extracted image features depending on how large a memory the user recording unit contains. This makes it possible to configure the memory size of the user recording unit to be compact by storing the corrected or compressed fingerprint data, or the extracted image features, which are more compact than the raw fingerprint data.

Therefore, neither the structure (or step) nor the advantages of claimed invention is disclosed in the references. These deficiencies of DiMaria '014 are not cured by any of the other applied references. Accordingly, the pending independent claims 1 and 10 are believed to be patentably distinguished over the applied prior art, and the dependent claims are also allowable for at least the same reason.

The dependent claims are also allowable for at least the same reasons as the independent claims on which they ultimately depend. In addition, they recite additional patentable features when considered as a whole.

In view of the foregoing amendments and remarks, applicants respectfully submit that the application is now in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application, or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is courteously invited to contact the undersigned attorney at the local telephone number below.

Respectfully submitted,

Date April 30, 2004

By Brian J. McNamara

FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 672-5490  
Facsimile: (202) 672-5399

Brian J. McNamara  
Attorney for Applicant  
Registration No. 32,789  
Aaron C. Chatterjee  
Registration No. 41,398

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.